

REMARKS

This Amendment is submitted in response to the Office Action dated June 20, 2006, having a shortened statutory period set to expire on September 20, 2006.

In paragraph 3 of the present Office Action, Claims 1-3, 5, 7-9, 11, 21, 23-26, 29 and 31 are rejected under 35 U.S.C. § 102(b) as anticipated by *Kesler*, U.S. Patent Application Publication No. US2002/0045437 A1. In addition, in paragraph 5 of the present Office Action, Claims 4, 12 and 27 are rejected under 35 U.S.C. § 103 as unpatentable over *Kesler* in view of U.S. Patent No. 6,300,863 to *Cotichini et al. (Cotichini)*. Those rejections are respectfully traversed, and favorable reconsideration of the claims is requested.

As an initial matter, Applicant respectfully points out that the rejection under 35 U.S.C. § 102(b) is defective because *Kesler* was published on April 18, 2002, more than 2 months after the filing date of the present application. In response to Applicant pointing out this deficiency in the rejection, the Examiner stated in a telephone conference on August 22, 2006, that the rejection was intended to be a rejection under 35 U.S.C. § 102(e). However, because *Kesler* was abandoned and never issued as a patent, *Kesler* is not available as a referenced under 35 U.S.C. § 102(e). Consequently, the § 102 rejection remains defective.

Applicant further respectfully submits that Claims 1-3, 5, 7-9, 11, 21, 23-26, 29 and 31 are not rendered unpatentable by *Kesler* because that reference does not disclose each claimed feature. For example, *Kesler* do not disclose a “method for determining a position of an electronic device within a wide area network including the electronic device and additionally including first and second network elements” that includes the following step of exemplary Claim 1:

distributing a tracing tool to the first network element within said wide area network (emphasis supplied).

As emphasized by the amendments to Claim 1, the first network element is distinct from the electronic device and second network element that also serve as components of the wide area network.

In paragraph 3 of the present Office Action, *Kesler's* tracing software 12 and computer 16 are respectively cited as disclosing the "tracing tool" and "electronic device" recited in exemplary Claim 1. The proposed alignment between *Kesler's* system and the claim elements thus discloses, in the language of Claim 1, the distribution of a tracing tool to the electronic device rather than to the first network element as claimed. Because *Kesler* does not disclose the "distributing" step of exemplary Claim 1, the rejection of Claim 1 under 35 U.S.C. § 102 in view of *Kesler* is overcome.

Exemplary Claim 1 is also patentable over *Kesler* because that reference does not teach or suggest "in response to detecting said physical separation, the first network element intercepting data of said communication on the wide area network between said electronic device and said second network element including said identifying indicia," as recited in Claim 1. With reference to this intercepting step, page 3 of the present Office Action cites paragraphs [0004] and [0009] of *Kesler*, which discloses "the tracing software [executing on computer 16] disconnects from the Internet and calls and (800) phone number without any prompt or alert" (*Kesler*, paragraph [0009]). As further described in paragraph [0018] of *Kesler*, the (800) phone call connects the computer to a call center that records the unauthorized user's caller ID (ANI).

Kesler's disclosure of computer 16 initiating an (800) call to a call center and the call center recording the ANI of the call does not disclose the claimed interception of data on a wide area network by the first network element as recited in Claim 1. Given the Examiner's citation of *Kesler's* server 14 as teaching the first network element and *Kesler's* call center as teaching the second network element, *Kesler's* disclosure of the capture of the ANI by the call center discloses, in the language of Claim 1, the second network element receiving data in a communication by an electronic device. *Kesler* does not teach or suggest the capture of the ANI by server 14 (cited as teaching the "first network element") during communication between computer 16 (cited as teaching the "electronic device") and the call center (cited as teaching the "second network element"). Claim 1, by contrast, explicitly states that the first network element monitors traffic on the wide area network and the first network element intercepts data communicated between the electronic device and the second network element. Because the cited portions of *Kesler* do not teach or suggest the "intercepting" step set forth in Claim 1, Applicant

respectfully submits that the rejection of exemplary Claim 1 under 35 U.S.C. § 102 in view of *Kesler* is overcome.

The foregoing remarks made with respect to Claim 1 are also applicable to and overcome the rejections of Claims 2-5, 7-8, 21 and 29, which depend therefrom, similar independent Claims 9 and 24, and their respective dependent claims.

With respect to the rejections of Claims 2, 21, 23 and 25, Applicant respectfully traverses the Examiner's assertion of inherency with respect to the claimed step of "distributing said tracing tool to a plurality of Internet protocol routers within said wide area network" as recited in exemplary Claim 2. It is well settled that a rejection based upon inherency requires that the Examiner demonstrate that a feature, although not explicitly disclosed by a reference, is nevertheless implicitly disclosed as a necessary, required feature of that reference. At page 3 of present Office Action, the Examiner merely indicates that *Kesler* discloses the installation of a "server part" of tracing software on *Kesler's* server 14. Such an installation does not require, and further does not show or suggest, installation of *Kesler's* tracing software on "a plurality of Internet protocol routers" as set forth in Claim 2 or even "a plurality of network elements" as recited in Claim 21. Consequently, Applicant submits that the rejections of Claims 2, 21, 23 and 25 are overcome.

Applicant further traverses the rejections of Claims 4, 12 and 27 under 35 U.S.C. § 103 as obvious over the combination of *Kesler* and *Cotichini* because the proposed combination of references lacks objective motivation or suggestion to combine the reference teachings. In paragraphs 3 and 5 of the present Office Action, the Examiner states that *Kesler*, while teaching determining an identifying indicia of an electronic device (i.e., the ANI of the call originated by the electronic device to the call center), fails to disclose "determining a media access control (MAC) address of said electronic device." Accordingly, the Examiner cites col. 16, lines 37-42 of *Cotichini* as disclosing the determining step of Claims 4, 12 and 27.

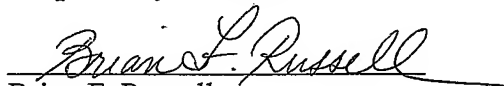
While *Cotichini* discloses a MAC address, there is no objective motivation or suggestion to combine *Cotichini* with *Kesler* in the manner suggested by the Examiner. In an attempt to

supply such motivation, the Examiner states in paragraph 5 of the present Office Action that the motivation to combine the references is "to locate a wide variety of missing or lost electronic devices such as portable computers, PDAs, PCs and cellular telephones." However, *Kesler's* system, without any modification by *Cotichini*, would permit any of the devices enumerated by the Examiner to initiate an (800) call to a call center and have the call center capture the ANI of the call, which ANI is utilized by *Kesler* to track the location of a stolen electronic device. Because the modification of *Kesler* proposed by the Examiner would not enhance the ANI tracking taught by *Kesler* and further would not expand the number of devices to which *Kesler's* invention is applicable as asserted by the Examiner, Applicant respectfully submits that the combination of *Kesler* and *Cotichini* is improper for want of objective motivation or suggestion and the rejections of Claims 4, 12 and 27.

In view of the amendments and remarks made herein, Applicant submits that all pending claims are allowable and earnestly solicits notice thereof.

No extension of time for this amendment is believed to be necessary. However, in the event an extension of time is required, that extension of time is hereby requested. Please charge any fee associated with an extension of time as well as any other fee necessary to further the prosecution of this application and credit any overpayment to **IBM CORPORATION DEPOSIT ACCOUNT NO. 09-0447.**

Respectfully submitted,


Brian F. Russell
Registration No. 40,796
DILLON & YUDELL LLP
8911 North Capital of Texas Highway
Suite 2110
Austin, Texas 78759
512.343.6116

ATTORNEY FOR APPLICANT(S)